



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/520,239	07/18/2005	Peter John Sadler	14084-005US1 / RJW/CP6263	5058
23575	7590	02/01/2007	EXAMINER	
CURATOLO SIDOTI CO., LPA 24500 CENTER RIDGE ROAD, SUITE 280 CLEVELAND, OH 44145			GALLIS, DAVID E	
			ART UNIT	PAPER NUMBER
			1609	
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
31 DAYS		02/01/2007	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	10/520,239	SADLER ET AL.	
	Examiner	Art Unit	
	David E. Gallis	1609	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 04 January 2005.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935-C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 16-35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) _____ is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) 16-35 are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 16 through 35 are pending.

Election/Restrictions

2. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 16 through 21 and 22 through 25, drawn to a Ruthenium (II) compound of formula (I).

Group II, claim(s) 26 through 35, drawn to a method of treating and/or preventing cancer by administering a therapeutically effective amount of a Ruthenium (II) compound of formula (I).

3. The inventions listed as Groups I and II do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

The technical feature linking Groups I and II lacks novelty as a Ruthenium (II) compound. Carmona et al. teach a Ruthenium (II) complex wherein with respect to the instant formula (I) R1=isopropyl, R2, R3, R5, and R6=H, R4=methyl, X=halo; T and T'=O, R=H, R1c and R3c=methyl (See Carmona, D. et al, "Synthesis, X-Ray Structure, and Nuclear Magnetic Resonance (1H and 13C) Studies of Ruthenium (II) Complexes containing Pyrazolyl Ligands", J. Chem. Soc. Dalton Trans., 1990:1463-1476 (1990), page 1464, structure (2).) This demonstrates lack of novelty with respect to the compound claimed.

Therefore a technical feature linking the inventions of Groups I and II do not constitute a special feature as defined by PCT Rule 13.2 as it does not define a contribution over prior art.

Accordingly, Groups I and II are not linked by the same or a corresponding special technical feature as to form a general inventive concept

4. This application contains claims directed to more than one species of the generic invention. These species are deemed to lack unity of invention because they are not so linked as to form a single general inventive concept under PCT Rule 13.1.

The species are as follows:

Species A: Any compound according to formula (I) of claim 16 defined to contain individually specific functional groups with respect to each of R1 through R6, X, T, T' R, R1c, and R3c as defined in claim 16.

Species B: Any compound according to formula (I) of claim 22 defined to contain individually specific functional groups with respect to each of R1 through R6, X, L, X and X' as defined in claim 22 (or individually specific functional groups with respect to formulas (II) through (X) or formulas (XI) through (XV) of claims 30 and 31 respectively, or T, T' R, R1c, and R3c as defined in claim 32 in lieu of L, X, and X' as defined in claim 22.)

Applicant is required, in reply to this action, to elect a single species to which the claims shall be restricted if no generic claim is finally held to be allowable. The reply must also identify the claims readable on the elected species, including any claims

subsequently added. An argument that a claim is allowable or that all claims are generic is considered non-responsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

5. The claims are deemed to correspond to the species listed above in the following manner:

Species A: Claim 16 and Claims 17 through 35 (in part)

Species B: Claim 22 and Claims 23 and 35 (in part)

6. The species lack unity because they differ in elements, bonding arrangements and chemical structure to such an extent that a reference anticipating any one group would not render the other group obvious, thus unpatentability of any group would not necessarily imply unpatentability of another group. The varying classes and subclasses of each diverse structure as delineated will constitute an enormous search burden.

7. The following claim(s) are generic: Claims 16 Through 35.

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

Art Unit: 1609

The election of an invention or species may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

Should applicant traverse on the ground that the inventions or species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions or species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C.103(a) of the other invention.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to David E. Gallis whose telephone number is 571-272-9068. The examiner can normally be reached on Mon-Fri 7:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisors, Cecilia Tsang or Andrew Wang can be reached on 571-272-1600. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

David E. Gallis
Patent Examiner

Cecilia J. Tsang
Cecilia J. Tsang
Supervisory Patent Examiner
Technology Center 1600